REMARKS

It is our understanding that claims 12-15 and 26-31 remain pending in this application, wherein claims 14 and 26 have been amended for reasons specifically remarked upon, below.

Preliminary item:

In drafting this response it was observed that claim 14 included a redundant instance of "*said*." Corrective amendment is made herein. No new subject matter is added by this.

We proceed now with reference specifically to the numbered items in the Action.

Items 1-3, 8, 5, 10, and 17-20:

These appear informational in nature and are understood to require no reply.

Item 4 (objection to claim 26):

Responsive to the Examiner's guidance, corrective amendment has been made to claim 26. No new subject matter is added by this.

Items 6-7 (§ 112, ¶2 rejections):

Claims 12-15 and 26-31 are rejected as being indefinite. Respectfully this is error.

The Action here states:

> *Claims 12, 26 and 29 recites the limitation ll all said keys ". There is insufficient antecedent basis for this limitation in the claim. The Examiner is confused about the number of keys required to unwrap the digital wrapper. There is a possibility that the user can unwrap the digital wrapper using one key ("receiving at least one key"), which contradicts with, for example, the limitation ("unwrapping said digital wrapper protecting said selection using all said keys required for said selection") of claim 12.*

Is the Examiner arguing that one of ordinary skill in the art here would not understand that "*receiving at least one key*" means one or more may be received, and that "*using all said keys*" then does not mean using one key if there is only one is received, using two keys if two are received, etc? We ask the Examiner to re-read MPEP 706.03 and reflect on whether he has here engaged in argument merely for the sake of argument.

Item 9 (§ 103(a) rejections, generally):

Claims 12-15 and 26-31 are rejected as being unpatentable (obvious) over Subler in view of Hurley. Respectfully this is error, as discussed with specificity below.

5   **Item 11 (§ 103(a) rejection of claim 12):**

The Action here first states that Subler discloses:

> · *wherein said assets are instances of the digital content and are protected from unauthorized use by a digital wrapper requiring at least one key for unwrapping (see at least column 1, lines 5-6 and 62-63, column 7, lines 10-13,*
10   *column 9, lines 32-48 and column 16, lines 20-27);*

However, col. 1, ln. 5-6 teach nothing about protection. This is merely a generalized, summarizing statement in Subler's Background of Invention section that does not purport to teach anything. Essentially the same applies to col. 1, ln. 62-63.

Col. 7, ln. 10-13 is at least in Subler's Description section where it invention is being
15   taught, but this is in a sub-section explicitly labeled "CD-ROM Database" (col. 7, ln. 9) and this explicitly discusses items in exactly that, a database in a CD-ROM. In contrast, claim 12 explicitly recites "*assets in a hard drive of a personal computer.*" The entirety of Subler's teaching cannot be ignored, and here it is clear that Subler is teaching away from a hard drive.

Col. 9, ln. 32-48 are a similar case of Subler is teaching away from claim 12. Subler
20   teaches encrypting information being stored in a CD-ROM, but again this is explicitly in CD-ROM and a then in a database therein.

And while col. 16, ln. 20-27 discusses single or hybrid key encryption schemes and does not say in what media, one of ordinary skill in the art would clearly understand this to mean in the media that Subler elsewhere teaches.

25   Continuing, the Action states that Subler discloses "· *subsequent to said delivery of said personal computer to said user, displaying on the personal computer information about said inventory (see at least column 3, lines 39-52).*" However, here even more clearly one has to look at what is delivered. Subler teaches delivering a CD, whereas claim 12 recites delivery of a hard drive in a personal computer. As is well known, the content of a CD-ROM is not displayed to a
30   user of a personal computer unless software is started that does this. This is why Subler, at col. 3, ln. 39-52, teaches that its CR-ROM includes such software. Implied in this, of course, is that such software has to be loaded or installed from the CD-ROM and then run. In contrast, the hard

drive based approach recited in claim 12 does not require loading or installing software. Such is already present on the hard drive, it will work (e.g., it is not like a CD with Macintosh software being put into a PC), and it is trustworthy because it came with the PC itself.

Continuing, the Action states that Subler discloses "· *accepting a selection representing a particular said asset from said user (see at least column 5, lines 5-30)*." However, the cite does not support the assertion. Col. 5, ln. 5-30 merely teaches accepting an order at a remote workstation; not local software accepting a selection that may later be part of an order.

Continuing, the Action states that Subler discloses "· *transmitting money representing payment for said selection and an identifier associated with said selection from the personal computer to a clearing house, via a communications system (see at least column 3, lines 30-31 and column 4, lines 51-64)*." However, this cite also does not support the assertion. Col. 3, ln. 30-31 teaches nothing about transmitting money (in fact, nowhere does Subler teach a financial clearing house). The text in the cite here merely says that items can be paid for. Similarly, col. 4, ln. 51-64 merely teach sending a order to purchase something – not money.

Continuing, the Action states that Subler discloses "· *unwrapping said digital wrapper protecting said selection using all said keys required for said selection (see at least column 15, lines 49-56)*." However, this cite also does not support the assertion. Col. 15, ln. 49-56 merely teaches vendor-side key handling and methods to send a key to purchaser. There is nothing here about the user-side and there receiving and using keys.

Continuing, now with respect to Hurley, the Action states that this "*discloses storing an inventory of assets in a hard drive of a personal computer prior to delivery of said personal computer to a user (see at least column 1 , lines 8-27).*" However, here as well, the Action merely a cites part of a generalized, summarizing statement in a Background of Invention section that does not purport to teach anything. Is this being asserted by the Office to be an enabling teaching?

Continuing, the Action states "*It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Subler's teachings to include the step of pre-storing digital content in the computer's hard-drive ...*" (underline added). Respectfully this on its face is taking just one step listed in the abstract, out of context and ignoring the rest of the teachings of the reference. Additionally, this states no rationale for substituting Hurley's hard

drive in place of Subler's CD-ROM, and still having a workable result in view of the rest of Subler's teachings.

Continuing, the Action states:

> ... before its delivered to the user to 1) ensure the compatibility of the digital content with the computer configuration, 2) to restrict the usage of the digital content to only one computer hard drive and 3) to reduce the cost of delivering the digital content to the user by not using a storage media such as CDROM's.

However, neither Subler or Hurley teach these advantages. In fact neither is capable of 1) or 2), taken alone or in combination, without additional features. In deed, it appears that these advantages can only been seen by the use of 20/20 hindsight based on applicant's disclosure, and only then if one ignores the other deficiencies in theses references.

Finally, where in this Action is a reasoned argument articulated for why Hurley's hard drive, or Hurley in general, can reasonably be combined with Subler? Respectfully, the recent U.S. Supreme Court ruling in *KSR International Co. v. Teleflex Inc.*, clarified many responsibilities of both the Office and of Applicants. One of these is that the Office must at least articulate for the record what reasoning supports references being combined (see e.g., MPEP 2141). This is lacking in this prosecution so far.

Item 12 (§ 103(a) rejection of claim 13):

The Action here states that Subler discloses "· *receiving at the personal computer a first said key from said clearing house (see at least column 10, lines 2-5).*" However, this is simply not correct. The cite describes an order taking system that generates and provides a key to an end user. This order taking system clearly is a vendor-side system, not one in a financial clearing house (e.g., a bank or similar financial institution).

Continuing, the Action states that Subler discloses "· *transmitting from the personal computer said first said key to a master server, via said communications system (see at least column 10, lines 5-11, column 15, lines 49-56 and column 18, lines 39-53).*" However, this is also incorrect. At col. 10, lines 5-11 Subler merely teaches that an end user generated request number is sent by that user's workstation to Subler's order taking system (which uses it to encrypt the key it then sends back). There are a number of problems applying this to claim 13. First, it has the order of operations backwards. In claim 13 the personal computer (at the end user side) receives a key and then that key is sent to a clearing house. Next, as already discussed,

Subler does not teach or reasonably suggest a clearing house. And next, the only storing taught here in Subler is on a network file server. In contrast, claim 13 recites that the first key goes to the master server "*via said communications system.*" Claim 13 depends from claim 12, where it can be seen that the communications system connects to the clearing house (e.g., is a public

5   network like the Internet). For the interpretation here in the Action to apply claim 13 one would have the ridiculous situation that the clearing house has access to the end user's file server.

Subler at col. 15, ln. 49-56 also does not support the assertion made in the Action. All this teaches is key generation at the order taker end, and key delivery from there to the end user end. The cite to Subler at col. 18, ln. 39-53, to all of its claim 19 is disingenuous, and begs the

10   question why (if there were any substance to the assertion) this is not an anticipation rejection. In any case, this also does not support the assertion. Nothing here teaches or reasonably suggests a key being transmitted from a personal computer or an end user workstation.

Continuing, the Action states that Subler discloses "·*receiving back at the personal computer a second said key from said master server (see at least column 10, lines 5-11 and*

15   *column 15, lines 49-56)*." However, as regards col. 10, ln. 5-11 we have established above that the master server in this claim is not merely an end user network file server, and thus that such a master server is not taught by Subler. Regarding col. 15, ln. 49-56, this teaches that Subler has two keys together at its order taking system. But this is clearly not analogous to claim 13, which has a 1st key from clearing house and a 2nd key from a master server.

20   **Item 13 (§ 103(a) rejection of claim 14):**

The Action here states "*Subler discloses wherein said (b) through said (f) are performed using a graphical user interface that presents said assets metaphorically as merchandise and units of service in aisles of stores (see at least column 1, lines 31 -40 and column 3, lines 46-*

25   *52)*." However, this is simply wrong. Neither cite has any teaching or reasonable suggestion of stores or of aisles therein, and utterly none for sales of units of service.

Item 14 (§ 103(a) rejection of claim 15):

The Action here states:

30   *Subler discloses wherein said graphical user interface further presents said stores metaphorically as a member of the set consisting of villages, town squares, shopping centers, and malls (the graphical user interface displays the*

hierarchically organized graphical representations of items or groups of items that are available to be ordered, see at least column 1, lines 31-40 and column 3, lines 46-52).

Again however, this is simply wrong. The cites here have no teaching or reasonable

5   suggestion of stores, aisles therein, or of units of service. Even more clearly, there is no support

in Subler for villages, town squares, shopping centers, or malls. As for the added parenthetical

comment, hierarchically organization in a GUI in general is irrelevant and that items are

displayed in one to be ordered (bought) is also irrelevant. For example, if one wants to buy a

candy bar and an automobile part. In a town square one walks into a candy store, makes a

10 purchase, walks across the street to the auto parts store and makes another purchase. Nothing in

Subler teaches or reasonably suggests a GUI, regardless of how things in it are organized, that

resembles a town square or provides such a user an experience.

Items 15 and (§ 103(a) rejection of claims 26, 27, 28, 29, 30 and 31):

15   The Action rejection here is based on the rationale applied to the other claims. However,

in view of the rebuttal provided above we urge that these claims are allowable for the same

reasons.

CONCLUSION

20   Applicant has endeavored to put this case into complete condition for allowance. It is

thought that the objection has been corrected by amendment, that the § 112 rejection has been

shown to be unfounded in logic, and that the § 103 rejections have been completely rebutted.

Applicant therefore asks that all objections and rejections now be withdrawn and that allowance

of all claims presently in the case be granted.

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